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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/665,143 | 09/22/2003 | Yoshimi Sato | 2003_1356 | 5804 |

513 7590 07/26/2004

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| EXAMINER |
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BRUNSMAN, DAVID M

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| ART UNIT | PAPER NUMBER |
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1755

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,143

Applicant(s)

SATO ET AL.

Examiner

David M Brunsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-22 is/are pending in the application.
- 4a) Of the above claim(s) 6-15, 21 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 16+1, 18+1, 19+1 and 20+1 is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-16 and 18-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

This application is a continuation of 09/793490, filed 27 February 2001, now abandoned. Applicant's remarks and amendment have been filed in response to the final rejection made in the parent application. The prosecution of the prior application is continued herein. Upon election, the scope and consideration of the elected claims was limited to coating solutions including a compound of formula (I), a corresponding Bi precursor, Sr alkoxide, Ta alkoxide and an *optional* B-diketonate stabilizer. Applicant's amendment has overcome the outstanding rejection for the parent application and the scope of consideration expanded to include a coating solution comprising a compound of formula (I), a Bi alkoxide, a metal A alkoxide and a metal B alkoxide including a "composite metal alkoxide" as defined at page 11 of the specification. Claims 1-3, 16+1, 18+1, 19+1 and 20+1 are allowable over the prior art of record. The prior art fails to teach or suggest the improved results obtained with the combination including a "composite metal oxide." The scope of consideration has been further expanded to include coating solutions comprising a compound of formula (II) and an organometallic compound containing the metallic element Bi.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5276012.

Instant claim 5 shows that the scope of claim 4 includes reaction products of an organometallic compound containing the metallic element Bi and compounds of formula (II). The reference discloses coating compositions comprising Dipivaloylmethanate (see column 3, line 56, an example of Formula (II)) complexes and Bi (see column 4, line 10 and claim

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3). US Patent 5767302 is provided simply as a factual reference supporting the finding that the dipivaloylmethane compounds of US 5276012 are reaction products of said organometallic compound and dipivaloylmethane.

Claims 6-15, 16+(4, 7, 10 or 13), 18+(4, 7, 10 or 13), 19+(4, 7, 10 or 13) and 20+(4, 7, 10 or 13) stand withdrawn from consideration as drawn to nonelected species. Claim 21, as amended, stands withdrawn from consideration as drawn to an invention non elected by prior presentation. Claim 21 is drawn to the hydrolysis/polycondensation product of any one of claims 1, 4, 7, 10 and 13. Claim 21 and the elected claims are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as a CVD source material and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Claim 22 stands withdrawn as a method of use as set forth previously.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David M Brunsman whose telephone number is 571-272-1365. The examiner can normally be reached on M, W, F, Sa; 6:00-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 571-272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David M Brunsman
Primary Examiner
Art Unit 1755

DMB

A handwritten signature in black ink, appearing to be 'DMB', with a long horizontal stroke extending to the right.